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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,269	04/03/2001	Renee Frengut	3313/IH343	2080

44538 7590 05/05/2005

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EXAMINER
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CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/825,269

**Applicant(s)**

FRENGUT ET AL.

**Examiner**

Donald L. Champagne

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed with an amendment on 27 January 2005 have been fully considered but they are not persuasive. The arguments are addressed at para. 6-8 and 12 below.

### *Specification*

2. The amendment filed 27 January 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. See the discussion of new matter introduced into the claims at para. 4-8 below.
3. Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The following limitation of every independent claim, e.g. at lines 6-8 of claim 1, is new matter: "wherein each user personally assists in the creation of his or her user profile by knowingly inputting the information and are aware that the information will be used to create a customized interface for each user profile."
6. Applicant argues (p. 10 of 11, 2<sup>nd</sup> para.) that the amendment has not inserted new matter. Yet applicant has added the three subject lines limiting the term "user profile", and the examiner can find no support in the disclosure for this limitation.

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7. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".
8. The instant application contains no such clear definition for the phrase "user profile". In the instant case, the examiner is required to give the term "user profile" its broadest reasonable interpretation, which the examiner judges to be any concise biographical description of the user (Merriam-Webster's Collegiate Dictionary, definition 5).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
10. Claims 1-3 and 6-30 are rejected under 35 U.S.C. 103(a) as being obvious over Gerace (US005848396A).
11. Gerace teaches (independent claim 1) a method for generating a customized home page (col. 4 line 3), which reads on a customized interface, comprising the steps of: associating in a computer one or more ads with respective ad profiles (col. 3 lines 4-10); associating in a computer one or more user profiles (col. 2 lines 3-15) with each user profile created from user responses to a gate information, which reads on created from information inputted by a corresponding user and transmitted to the computer, wherein each user personally assists in the creation of his or her user profile; determining matching ad profiles by comparing the

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ad profiles with user profiles for matches (col. 2 lines 31-34 and col. 35 lines 64-67), and selectively including in the interface (page) of a user at least one of the one or more ads associated with the ad profiles matching a user profile associated with the user (col. 2 lines 24-29).

12. Gerace does not teach that each user personally assisting in the creation of his or her user profile comprises knowingly inputting the information and are (being) aware that the information will be used to create a customized interface for each user profile. Because it would eliminate a “great challenge” taught by Gerace (col. 21 line 41), enable the identification of multiple users at a given computer, because the personalized agate information provided by Gerace (col. 1 line 50 to col. 34 line 27) would be attractive to many users, because many users would appreciate that said personalized agate information must come at a cost, and would be willing to provide personal information and accept the profiling as payment for said information, and because many users would want to receive well-targeted ads, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Gerace that the user register by providing location and basic personal identification and demographic information, and agree to accept the profiling in return for receiving the personalized home page/interface with agate information, which reads on each user personally assisting in the creation of his or her user profile by knowingly inputting the information and being aware that the information will be used to create a customized interface for each user profile.
13. Gerace also teaches: (independent claims 6 and 30) storing statistical data determined according to the matches (col. 2 lines 35-42), selecting the ad(s) according to said statistical data and an anonymous user (col. 2 lines 43-53 and col. 32 lines 54-56); (independent claim 9) charging the advertiser in accordance with the matches (col. 12 lines 7-21); (independent claims 27 and 16) providing the page/interface to the user, in response to a user action (logging on to *program 31*, col. 4 lines 1-2 and 25-27); and (independent claim 12) formatting the page/interface in accordance with the user profile (col. 2 lines 16-23).
14. Gerace also teaches at the citations given above claims 2, 3, 17 and 29. Claims 2, 3 and 17 are therefore taught inherently. Claim 29 is also taught inherently because no special meaning is disclosed for “consistent”.

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15. Gerace also teaches at the citations given above claims 7, 8, 10 (where "number of users having matching user profiles" reads on *number of times the ad is presented to and viewed by users*), 18-23 and 28 (where the ad profile parameters themselves read on "information about a targeted audience for the ad").
16. Gerace also teaches claim 15, because the *Page Display Object 35c* defines page outlines (col. 7 lines 39-40), which read on a page "framework", and the user adds said *outline/framework* to the user profile by selecting such a page for viewing (col. 7 lines 53-57). Accordingly, Gerace also teaches claims 13 and 14 because these outlines (Appendix I beginning in col. 23) fully define page outlines including spaces.
17. Gerace does not teach (claims 11 and 24) charging the advertiser based on the amount of ad space available. Because both ad cost and demand from advertisers increases with ad size, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Gerace that advertisers are charged based on the amount of ad space available. Gerace does teach the added limitations of claim 25 (col. 2 lines 16-23).
18. Gerace does not teach (claim 26) charging the advertiser based on when the user receives the ad. Because the value to the advertiser depends on the timing of some ads (e.g., Christmas sale ads are valuable only before Christmas), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Gerace that advertisers be charged based on when the user receives the ad.
19. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being obvious over Gerace in view of Tuzhilin (US006236978B1).
20. Gerace does not teach that the user profile defines one or more advertisers or favorite products. Tuzhilin teaches (col. 11 lines 21-23) that the user profile defines one or more favorite brands, which reads on advertisers or favorite products. Because Tuzhilin teaches the construction of dynamic profiles for large groups of users (col. 1 line 52 to col. 2 line 20), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Tuzhilin to those of Gerace.

### ***Conclusion***

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
24. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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26. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
27. Applicant may have after final arguments considered and amendments entered by filing an RCE.
28. **ABANDONMENT** – If examiner cannot by telephone verify applicant’s intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office’s web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

Donald L. Champagne  
Primary Examiner  
Art Unit 3622

29 April 2005